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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/761,025 | 01/16/2001 | Shin Utsunomiya | KOGYO-7 | 4717 |

7590 07/31/2003

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EXAMINER

MCCLENDON, SANZA L

| | |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1711

DATE MAILED: 07/31/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-------------------|-------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/761,025 | UTSUNOMIYA ET AL. |
| | Examiner | Art Unit |
| | Sanza L McClendon | 1711 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 21 May 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 5-18 is/are pending in the application.

4a) Of the above claim(s) 5-10 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 11-13 and 15-17 is/are rejected.

7) Claim(s) 4 and 18 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Pri ority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.

4) Interview Summary (PTO-413) Paper No(s). _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

Response to Amendment

1. In response to the Amendment received on May 21, 2003, the examiner has carefully considered the amendments. The examiner acknowledges the cancellation of claims 1-4 and the addition of claims 11-18. The claim rejection under 35 U.S.C. § 112, 2nd paragraph for claims 1-3 have been overcome by the amendment and has hereby been withdrawn for consideration.

Response to Arguments

2. Applicant's arguments with respect to claims 1-4 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102/ 35 USC § 103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having

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ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11-13, and 15-17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Okuhara et al (5, 102, 775).

Okuhara et al teaches visible light sensitive electrodeposition coating compositions and image-formation methods using the same. Said compositions comprises a photocurable resin (A) capable of being crosslinked or polymerized by light irradiation and ionic groups, a sensitizer (B), a water-insoluble photoinitiator (C), and at least one specific nitrogen-containing compound (D). In addition, the composition can comprise a neutralizing agent, such as an alkanolamine and ammonia—see column 22, lines 25-33, solvents, and other photocurable resins or vinyl monomers other than the photocurable resin (A)—see columns 21-22. Said composition is preferably diluted with water—see column 23, lines 25-32. Wherein the ammonia is deemed to anticipate or render obvious claim 17.

Said photocurable resin can be a photocurable resin comprising (meth) acryloyl groups and can be prepared by linking a glycidyl group containing unsaturated compound to an acrylic resin having a high acid value. Said acrylic resin can be obtained by copolymerizing an α,β -unsaturated acid, such as acrylic or methacrylic acid with at least one unsaturated monomer selected from the group in column 4, lines 57-61, wherein hydroxyethyl acrylate is taught. Said glycidyl group containing unsaturated compound can be selected from glycidyl acrylate or glycidyl methacrylate—see column 5, lines 5-6. Per synthetic example 1, Okuhara et al teaches making an acrylic copolymer and reacting with glycidyl methacrylate. Per example 1, Okuhara et al teaches neutralizing with triethylamine and adding a sensitizer, a solvent and an initiator then curing with visible light. Once cure the coated substrate is then developed in an aqueous 1% sodium carbonate solution and washed with water. Okuhara et al does not expressly teach a photocurable resin comprising

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the structural moieties as defined in claim 11, however Okuhara et al teaches said photocurable resin (A) can be obtained by copolymerizing acrylic acid with the acrylates as found in column 4, lines 57-61, wherein the examiner contends all listed compounds are equivalent. Therefore the examiner contends that one of ordinary skill in the art, could have replaced at least one mono-acrylate monomer found in synthesis example 1 with hydroxyethyl acrylate, and obtained a resin with the structural units and definitions found in claim 1. The motivation would have been the expectation of obtaining a composition for electrodeposition that is capable of forming of an image of high resolving power with the expectation of adequate success in the absence of unexpected results.

Allowable Subject Matter

6. Claims 4 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: the prior art fails to teach adding a colorant to composition as defined in claim 1, nor does the prior art teach developing a composition on a substrate with a neutral solution of water.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L McClendon whose telephone number is (703) 305-0505. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned

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are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0657.

Sanza L McClendon

Examiner

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SMc

July 28, 2003



James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700